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J.R.
04/23/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

C. UEMATSU et al

Appl. No. 09/842,791

Group Art Unit: 1634

Filed: April 27, 2001

Examiner: J. Taylor *Whisenant*

For: METHOD FOR ASSAYING DNA FRAGMENTS IN MIXTURE

TERMINAL DISCLAIMER

Commissioner for Patents
BOX FEE AMENDMENT
Washington, D.C. 20231

Sir:

This is a terminal disclaimer under Rule 321(c) to obviate a nonstatutory double-patenting rejection over a patent, which is being filed in response to an office action of October 25, 2002 (Paper No. 8), in reference to the above-identified patent application.

The owner, Hitachi, Ltd., a corporation organized under the laws of Japan, having a place of business at New Marunouchi Bldg., 5-1, Marunouchi 1-chome, Chiyoda-ku, Tokyo, 100-8220, Japan, who holds a 100 percent interest in both the above-identified application and U.S. Patent No. 6,225,064, disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term, defined in 35 U.S.C. §§ 154, 156, and 173 as shortened by any terminal disclaimer filed prior to the grant, of U.S. Patent No. 6,225,064.

The owner agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and U.S. Patent No. 6,225,064 are commonly owned.

This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors, or assigns.

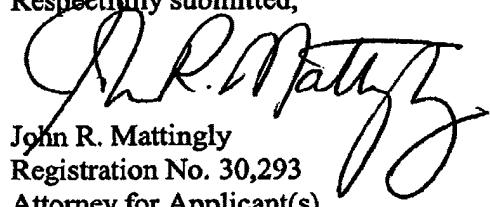
In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term, as defined in 35 U.S.C. §§ 145 to 156 and 173, of U.S. Patent No. 6,225,064, as shortened by any terminal disclaimer filed prior to its patent grant, in the event that such patent: (1) expires for failure to pay a maintenance fee, (2) is held unenforceable, (3) is found invalid by a court of competent jurisdiction, (4) is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §§ 1.321, (5) has all claims cancelled by a re-examination certificate, (6) is reissued, or (7) is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that any such willful false statement may jeopardize the validity of the application of any patent issued thereon.

A check for the fee of \$110 for a terminal disclaimer under 37 C.F.R. § 1.20(d) is enclosed. Two copies of this correspondence are enclosed.

Respectfully submitted,



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Date: January 27, 2003

DETAILED ACTION

Claim Objections

1. Claims 17-22 are objected to because of the following informalities: the claims are replete with minor grammatical errors. For example: the word "the" should precede "same" in the claims. Also, in claim 17 the word "first" appears after "second" in line 10 of the claim. In claim 21, the claim should read "which *have* different sequences", not "has". Also in claim 21, the word "and" should appear before the word "amplifying". This is not a comprehensive list of examples, but intended to show that the claims have multiple grammatical errors. Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 17-22 are rejected under the judicially created doctrine of double patenting over claims 1-4 of U. S. Patent No. 6,225,064 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.